SUPREME COURT, U. S.

FILED
JUN 27 1961
JAMES R. BROWNING, Clerk

IN THE

SUPREME COURT OF THE UNITED STATES

October Term, 1960

No. 182

GEUDER, PAESCHKE & FREY CO.,
a corporation,

Petitioner,

vs.

JOHN R. CLARK,
and
J. R. CLARK COMPANY,

Respondents.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

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Petitioner prays that a Writ of Certiorari issue to review the judgment of the United States Court of Appeals for the Seventh Circuit entered in the above entitled case on March 30, 1961.

OPINIONS BELOW

The opinion of the Court of Appeals for the Seventh Circuit entered March 30, 1961 is reported at 288 F. 2d 1 (1961). The opinion of the District Court for the Eastern District of Wisconsin is reported at 26 FRD 223 (1960) and also appears at pages 99-108 of the printed Appendix filed in the Court of Appeals. Copies of the opinion and judgment of the Court of Appeals are attached hereto as Supplements A and B respectively.

JURISDICTION

The jurisdiction of this Court is invoked under 28 USC § 1254(1).

QUESTION PRESENTED

In this independent action petitioner sought to restrain the respondents Clark from obtaining a money judgment for the infringement of Claim 1 of Olander Patent No. 2,663,102 which issued on an application filed June 9, 1950 and was held valid (259 F. 2d 737) as covering an ironing board with a supporting leg structure offset from the center of the board to provide knee room, because the same invention, described in Claim 14 of Hortman Patent No. 2,896,347, was subsequently held patentable (264 F. 2d 911), said Hortman patent, however, issuing on a prior application filed April 12, 1950. Said two claims, except for the colored underscoring, read as follows:

OLANDER CLAIM 1	HORTMAN CLAIM 14
In an ironing table having an elongated ironing board,	In an adjustable and collapsible ironing table, a relatively long and narrow table top to be positioned at various heights, including low heights for sit-down ironing, during use of the table,

a supporting structure for the board comprising a front leg member and a rear leg member

respectively secured at longitudinally spaced points to the underside of the board

and extending angularly downwardly to cross each other at a point above their longitudinal centers whereby the lower ends of the leg members will be spread further apart than their upper ends,

said members consisting of single bars pivoted together at their intersection

and with their parts above the intersection lying adjacent to the vertical longitudinal plane of one lateral edge of the board, and

the lower ends of the leg members having rigid transverse extensions underlying the table to support the table against lateral tilting. (A. 5)

a supporting structure comprising a pair of legs

pivotally interconnected intermediate their ends and extending lengthwise of the table,

said supporting structure being of sufficiently narrower width than said top,

and being laterally offset in relation to the longitudinal axis of said top sufficiently, at least in those portions to be disposed in the vicinity of the user's knees, to provide room for the knees opposite said portions beneath the top and thereby permit use of the table for sit-down ironing,

a fixed pivot connection between said top and one of said legs, a sliding pivot connection between said top and the other leg to enable adjustment and collapse of the table, manually-controllable means for retaining the slidable pivot in different positions when the table is set up for use, enabling the positioning of said top at various heights including low heights for sit-down ironing, and

feet portions on said legs constructed to provide stable support for the ironing table despite the aforementioned laterally offset relation. (A. 8-9)

Did the Court of Appeals err when it denied leave to the District Court to entertain this independent action (288 F. 2d 1) by disposing of the issue as to the identity of invention with the following inadequate conclusory comment:

> "Although the phraseology of Claim 14 of the Hortman Patent and Claim 1 of the Olander Patent are, in some respects, similar, there are important differences. The two claims are directed to different concepts and combinations of elements. Claim 14 of the Hortman Patent does not respond to certain limitations contained in Claim 1 of the Olander Patent."

CONSTITUTIONAL PROVISION AND STATUTES INVOLVED

Article I, Section 8, Clause 8 of the United States Constitution:

> "The Congress shall have power * * * To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries."

35 USC § 102:

> "A person shall be entitled to a patent unless—
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or
> * * *
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent,"

35 USC § 103:

> "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

STATEMENT OF THE CASE

An interlocutory judgment entered by the District Court in a prior case between the parties held Claim 1 of Olander Patent No. 2,663,102 valid and infringed. See 159 F. Supp. 948. Such judgment was affirmed by the Court of Appeals. See 259 F. 2d 737.

This is an independent action seeking to enjoin Clark, plaintiffs in the prior case and respondents here, from proceeding further to a money judgment on the grounds that 1) *subsequent to said affirmance*, Patent No. 2,896,347 issued on July 28, 1959 to one Hortman, 2) Hortman Claim 14 was for the same invention as Olander Claim 1, both claims being directed to the combination of an ironing table top supported by a leg structure offset from the middle of the table top to provide knee room for sit-down ironing as well as being adjustable for stand-up ironing by persons of different heights, and 3) Hortman as inventor filed his application prior to the filing of the Olander application and Clark, as Olander's assignee, has elected to stand on the Olander filing date as the date of his alleged invention.

Olander Claim 1 was judicially interpreted in the prior case between the parties (159 F. Supp. 948 and 259 F. 2d

737) and Hortman Claim 14 was judicially interpreted by the Court of Customs and Patent Appeals in *Application of Hortman*, 264 F. 2d 911 (CCPA 1959). The other material facts stated chronologically are as follows, with references to the printed Appendix in the United States Court of Appeals for the Seventh Circuit being noted as (A. .....):

April 12, 1950

Hortman filed his patent application on an ironing table (A. 21) with the supporting legs "not at the center of the ironing table top, thus providing a greater amount of knee room on one side of the ironing table for the convenience of the user when it is desired to iron in the sitting position" (A. 23, Col. 6, lines 2-5) and claiming "An adjustable height ironing table, * * * said supporting members as an assembly being offset from the longitudinal axis of the table top to provide more clearance on one side of the table than on the other, * * *." (A. 111)

June 9, 1950

Olander filed his patent application. (A. 7, 97)

Dec. 22, 1953

Patent No. 2,663,102 issued to Olander with sixteen claims, including Claim 1 involved herein. (A. 97)

May 12, 1954

Respondents Clark filed suit in the United States District Court for the Eastern District of Wisconsin against Petitioner (GP&F) for infringement of Claim 1 only of said Olander patent.

Sept. 11, 1956

A Stipulation was filed in the prior case in which "the parties agreed that the only issues to be presented for

trial * * * " as to validity were whether Claim 1 of the Olander Patent No. 2,663,102 was rendered invalid by the Busch, Pope or Lowenberg patents or by the "Mary Proctor" ironing table made by the Proctor Electric Company and sold August 25, 1949. (A. 68, 69)

January 28-29, 1957

During trial of the prior case counsel for GP&F stated that the "Mary Proctor" board stipulated to have been sold August 25, 1949 was relied upon as prior art because as of then "no date of invention by Olander has been carried back prior to the date of the filing of his application * * * " on June 9, 1950, counsel for Clark stating "That's quite understandable and agreeable", and counsel for each party acknowledging ignorance of what was happening in the Patent Office on a Hortman patent application, referred to in a patent issued to Hild, Clark's counsel commenting "I assumed it was abandoned quite a long time ago." (A. 70)

Dec. 19, 1957

On the basis of the evidence presented (A. 108), the District Court held Olander Claim 1 valid and infringed by GP&F. (159 F. Supp. 948)

Oct. 10, 1958

Validity of Olander Claim 1 was affirmed by the Seventh Circuit Court of Appeals. (259 F. 2d 737)

Feb. 24, 1959

Certiorari denied by this Court, Mr. Justice Douglas noting his view that certiorari should be granted. (359 U. S. 914)

April 13, 1959

A Special Master was appointed for the accounting in the prior case, which is presently pending in the District Court. (A. 7)

May 4, 1959

There was published at 121 USPQ 218 the decision of the Court of Customs and Patent Appeals reversing the Patent Office and holding that what is now Claim 14 of Hortman Patent No. 2,896,347 defined patentable subject matter. The decision also is reported as *Application of Hortman,* 264 F. 2d 911 (1959).

July 28, 1959

Patent No. 2,896,347 containing said adjudicated Claim 14 issued to Hortman on his application filed April 12, 1950, and the entire Hortman file wrapper for the first time became available to counsel for GP&F. (A. 76)

Aug. 12, 1959

This independent action was instituted to enjoin respondents Clark from enforcing the interlocutory judgment in the prior case because Hortman Claim 14 had a prior application date, and described the same invention as, that described in Olander Claim 1.

August 1, 1960

The District Court dismissed this independent action on the ground it lacked jurisdiction to consider the complaint on its merits because GP&F had not first obtained from the Court of Appeals leave to commence such action. (26 FRD 223)

March 31, 1961

The Court of Appeals affirmed said District Court ruling but also held that granting GP&F such leave would be a useless gesture. (288 F. 2d 1)

REASONS FOR GRANTING THE PETITION FOR WRIT OF CERTIORARI

This independent action is based on the issuance, *after affirmance* by the Court of Appeals of the interlocutory judgment in the prior case, of United States Letters Patent No. 2,896,347 on Hortman's application filed prior to the Olander application, Claim 14 of which describes the same invention as that described in Olander Claim 1. Since respondents Clark elected not to carry Olander's date of invention back to his later filing date, and the respective dates of invention are the filing dates in the absence of other proof,[1] the invention described in Hortman Claim 14 is prior to that described in Olander Claim 1.

It is well established that only one valid patent can be issued for a single invention, *Miller v. Eagle Manufacturing Co.*, 151 U.S. 186 (1893), and the right to such grant is in the first inventor. *Coffin v. Ogden*, 19 Wall. (85 U.S.) 120 (1874) and 35 USC § 102(a). Accordingly, if Hortman Claim 14 and Olander Claim 1 are for the same invention, the judgment of the Court of Appeals sought to be reviewed validates two outstanding patents for the same invention in contravention of Article I, Section 8, Clause 8 of the United States Constitution and the statutes.

The enforcement of the constitutional and statutory prohibition against such a situation involves a matter of public policy in which the public interest is paramount and dominant. See *Edward Katzinger Co. v. Chicago Metallic Mfg. Co.*, 329 U.S. 394, 400 (1947) and *Mercoid Corp. v. Mid-Continent Investment Co.*, 320 U.S.

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[1] *Sundh Electric Co. v. Interborough Rapid Transit Co.*, 198 F. 94 (2d Cir. 1912) and *Automatic Weighing Machine Co. v. Pneumatic Scale Corp.*, 166 F. 288 (1st Cir. 1909).

661, 665 (1944). Manufacturers of ironing tables now stand exposed to charges of infringement from the owners of each of the outstanding Olander and Hortman patents, although the monopoly conferred by a patent can constitutionally be granted only on the basis of an intended public benefit from such monopoly. Where no such benefit can occur, for the reason the invention is taught by another, the public interest requires the striking down of the invalid patent mistakenly issued to the subsequent "inventor" and by enjoining the enforcement of judgments based on such void patent.

Petitioner respectfully submits that the requested Writ of Certiorari should issue in the public interest. The District Court did not rule upon the issue of whether Olander Claim 1 and Hortman Claim 14 are for the same invention and the statement by the Court of Appeals that there are "important differences" is a mere conclusion. The Court of Appeals did not, and a mere reading of the two claims set forth above demonstrate that it could not, specify in its opinion detailed or evidentiary support for its conclusion.

A READING OF OLANDER CLAIM 1 AND HORTMAN CLAIM 14 DISCLOSES THAT THEY DESCRIBE THE SAME INVENTION

The following comparison of the two claims, which are set forth side by side at pages 2-3 hereof, demonstrates that they contain corresponding recitals of like elements:

1. Each claim commences by reciting the usual "elongated ironing board" (Olander) or "relatively long and narrow table top" (Hortman).

2. Each claim continues by calling for "a supporting structure" of two legs, Olander calling his legs "a front leg member and a rear leg member" and Hortman reciting "a pair of legs".

3. Olander next secures his legs "at longitudinally spaced points to the underside of the board," and Hortman recites "a fixed pivot connection" and a "sliding pivot connection" between his legs and the table top. Hortman recites more detail in this portion of his claim but the Court of Customs and Patent Appeals specifically stated that this did not distinguish from the prior art and was not a part of the inventive thought. See 264 F. 2d 911 at 913.

4. Olander's fourth recital is that his legs extend "angularly downwardly to cross each other at a point above their centers". Hortman describes the same structure as a pair of legs "pivotally interconnected intermediate their ends and extending lengthwise of the table," and this obviously will result in an angular downward disposition with a crossing of the two legs, just as Olander recited. As for crossing at a point above the leg centers, the Hortman drawings show this concept (A. 15) which also is notoriously old (see King Patent No. 260, 210, at A. 41; Rock Patent No. 431, 530 at A. 47; and Northrup Patent No. 1, 161, 407 at A. 49).

5. Olander continues by reciting that his members each consist "of single bars pivoted at their intersection". Such pivoted connection was recited in a previous part of Hortman's claim and he matches the single bar recitals with the statement "said supporting structure being of sufficiently narrower width than said top". Here we see that each applicant is reciting a leg structure of sufficiently narrow width, with the result that knee room will be

obtained when the leg structure is offset from the center of the table top. Hortman discloses in his drawings one single bar leg and one double bar leg but the selection of two single bar legs, as Olander recites, is a mere matter of choice.

6. Olander then positions the parts of his legs above their intersections "adjacent to the vertical longitudinal plane of one lateral edge of the board." Hortman closely parallels this by reciting, *in broader language,* that his legs are "laterally offset in relation to the longitudinal axis of said top sufficiently, at least in those portions to be disposed in the vicinity of the user's knees, to provide room for the knees". Here each inventor is moving his leg structure laterally from the center line of the table top to obtain the knee room, which, as hereinafter discussed, has been judicially interpreted in the case of both Hortman Claim 14 and Olander Claim 1 to be the essence of their inventive thought. Olander's specific amount of offset to the edge is admittedly old (A. 93) as shown in Lowenberg (A. 55). It does not distinguish inventively.

7. Each claim closes with a recital of transverse feet at the lower end of the legs to provide stability. Olander recites "rigid transverse extentions * * * to support the table" and Hortman reads "feet portions * * * to provide stable support."

Manifestly both claims are directed to the same concept of providing knee room through employment of a narrow leg structure offset to one side of the longitudinal center of the table top and comprised of angularly crossed legs pivoted to one another and with transverse feet for stability.

The Judicial Interpretations

a) Hortman Claim 14 was rejected by the Patent Office for failure to define invention over the prior art and the Court of Customs and Patent Appeals, in reversing the Patent Office, discussed the contents of such claim at length. That Court, in determining that Hortman Claim 27 (ultimately renumbered claim 14) defined patentable invention, specifically noted that the invention lay in offsetting the leg structure for facilitating sit-down ironing:

> "On the other hand, we do not agree with the board that inventive faculty is lacking in appellant's recitation in each claim on appeal of the
>
> > "'* * * supporting structure being of sufficiently narrower width than said top and being laterally offset in relation to the longitudinal axis of said top sufficiently, at least in those portions to be disposed in the vicinity of the user's knees, to provide room for the knees opposite said portions beneath the top and thereby permit use of the table for sit-down ironing, * * *.'" (264 F. 2d 911, 913, 914)
>
> "We are of the opinion that the element of laterally offsetting the supporting structure in relation to the longitudinal axis of the ironing board top, in order to create more knee space, is a feature that would not be suggested to one skilled in the art from a consideration of the primary references in the light of the Lowenberg disclosure." (264 F. 2d 911, 914)

The Court of Customs and Patent Appeals further noted that portions of the claim language were for old well known elements that did not pertain to the inventive contribution:

> "Some of the claimed features alleged by appellant to be novel are anticipated by the references. Adjustable means providing for a wide range of

> positions of the ironing table top are disclosed in the King, Rock and Northrup patents. Although the extent of adjustment differs in each reference, the basic principle is the same. Therefore, the broad recitation of this element in the appealed claims cannot be relied upon to distinguish over the prior art. Likewise, the feature of extending the feet to 'provide stable support for the ironing table' is of obvious applicability to any table, as shown, for example, by Lowenberg." (264 F. 2d 911, 913)

It is clear from the foregoing that a patent for Hortman Claim 14 was finally granted because of the offsetting of a narrow leg structure to one side so as to secure knee room for sit-down ironing.

b) The judicial interpretation of Olander Claim 1 in the prior case indicates that the validity of such claim also was sustained only because of such an offset leg structure to secure knee room for sit-down ironing. The Court of Appeals for the Seventh Circuit in such case discussed the problem of ironing in the following language at 259 F. 2d 737 at page 738:

> "The principal reason why hand-ironing was so tiring was that the housewife had to stand while ironing, or sit on a high stool with her knees either spread apart or twisted to one side because of the interfering leg structure of the ironing table. There are some types of ironing where the housewife prefers to stand, *but usually ironing can be more comfortably accomplished while sitting,* provided the table can easily be lowered to a level where the housewife can work from an ordinary chair, *and provided the supporting structure is so designed* that she can sit with her *knees in a normal forward position* and *with the surface of the table brought completely over her lap* so she need not bend forward while working." (Italics supplied)

The Court of Appeals in the prior case resorted to the doctrine of equivalents in deciding the infringement issue and held that the GP&F board, in which the leg structure was not contiguous with nor intersected by the vertical plane passing through the lateral edge of the table top as called for in Olander Claim 1, achieved "Practically the same result * * * for there is only three-eights of an inch difference in *knee room* or *leg space* between the two tables." (259 F. 2d 737, 740—italics supplied)

The Court of Appeals also affirmed the following Finding of Fact made by the District Court:

> "11. The ironing table shown and described in the Olander patent is so constructed that it can be readily adjusted to various sit-down and stand-up positions, to accommodate short or tall operators, the supporting structure including pivotally connected single bar leg members the upper portions of which are disposed adjacent to the vertical plane of one lateral edge of the top member, providing knee and leg space so that the operator can position the top member directly and fully over her lap; while the leg members are pivoted above their longitudinal centers so as to span a wide floor supporting area and thus form a rigid supporting structure for the top member regardless of the elevation to which it is adjusted." (159 F. Supp. 948, at 949)

It is apparent from the judicial history that the inventive concept in the two outstanding patents resides in the same catalog of elements for providing knee room for sit-down ironing. Only Hortman, as the first inventor, is entitled to a patent monopoly on such invention. Thus enforcement of a judgment based on Olander Claim 1 should be enjoined for to permit Olander or his assignee to exact a toll, and to continue to do so from others, on a void patent is unconscionable.

Differences Between the Claims are Non-inventive

The Court of Appeals for the Seventh Circuit held at 288 F. 2d page 4 in the present case:

> "Although the phraseology of Claim 14 of the Hortman Patent and Claim 1 of the Olander Patent are, in some respects, similar, there are important differences. The two claims are directed to different concepts and combinations of elements. Claim 14 of the Hortman Patent does not respond to certain limitations contained in Claim 1 of the Olander Patent."

No other enumeration of the so-called "important differences" in language was made by the Court.

We submit that any existing differences in the claim language are no more than the natural product of two attorneys independently striving to define the same invention. They also are clearly insignificant in the field of patent law.

The principal differences in claim language are (1) language in Hortman pertaining to the pivoted connections and controllable means for retaining the pivot in different positions to obtain adjustable height, and (2) narrower recitals in Olander of single bar legs offset to the very edge of the table. As noted on pages 13-14 hereof, the Court of Customs and Patent Appeals concluded with respect to the first difference that the adjustable heights and manner of attaching the legs to the underside of the table are old as shown in the art and that no invention resided therein. With respect to the second difference, Clark's counsel has admitted that these elements are each old in the art as taught by Lowenberg (A. 91, 96) and to substitute an old, known element into the Hortman combination cannot be an inventive distinction that

saves Olander Claim 1. See also *In re Weber*, 88 F. 2d 489, 491 (CCPA 1937)

Consequently, even when considering the differences between the claim language, the validity of each claim in terms of invention must be based upon the same concept of offsetting a narrow leg structure to obtain knee room for sit-down ironing.

To sustain Olander Claim 1 it must be found patentable over the invention of the prior inventor Hortman. This involves application of 35 USC § 103, a codification of the rule of *Hotchkiss v. Greenwood*, 11 How. (52 U.S.) 248 (1850) which states:

> "* * * for unless more ingenuity and skill in applying the old method of fastening the shank and the knob were required in the application of it to the clay or porcelain knob than were possessed by an ordinary mechanic acquainted with the business, there was an absence of that degree of skill and ingenuity which constitute essential elements of every invention. In other words, the improvement is the work of the skillful mechanic, not that of the inventor."

The Court of Appeals apparently overlooked this test and the case of *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147 (1950) which held that a patent for a combination of old elements may be granted only when such elements perform a new or different function than they perform out of combination. Such a finding was not and could not be made in this case. The old elements of Olander correspond element for element with the Hortman elements and no new function or result is obtained by Olander, but rather his intended result is identical to that of Hortman.

Patents issued on copending-prior filed applications may be used as a reference in deciding the question of invention. See *Alexander Milburn Co. v. Davis-Bournonville Co.*, 270 U.S. 390 (1926), *Detrola Corp. v. Hazeltine Corp.*, 313 U.S. 259 (1941) and 35 *USC* § 102 (e). Thus the Hortman patent with its express claims are part of the prior art over which Olander Claim 1 must patentably distinguish. The differences in the Olander claim clearly do not meet the standard of invention, for Olander only involves (1) substituting the known use of two single bar legs into the Hortman teaching, and (2) a mere increase in the offset of the legs to a degree also already known in the table art. These simple alterations were both old with Lowenberg and it takes only modest mechanical skill to make such changes. The changes are both intimated by Hortman, since he shows a single bar leg and he does not limit the degree of offset. In fact Olander Claim 1 only presents a limited version encompassed by Hortman Claim 14.

The decision of the Court of Appeals certainly does not resolve the conflict between Hortman Claim 14 and Olander Claim 1 by merely noting that there are some differences *in language* as to concepts, combination of elements and limitations. As was said by Judge Manton in his dissent in *International Signal Co. v. Vreeland Apparatus Co.*, 278 Fed. 468 (2d Cir. 1921) at pages 474-475:

> "* * * The rule of construction in a proceeding of this kind forbids the outstanding of two grants of patents for the same invention. Such a situation is created where the same inventive thought is described in two patents in quite different language. It was this view which has led to a great number of decisions which find infringement or lack of infringement, irrespective of the presence or absence

of the literal response to the language of the claim. Benjamin El. Co. v. Northwestern Co., 251 Fed. 291, 163 C.C.A. 444; Geoghegan v. Ernst, 256 Fed. 671, 168 C.C.A. 64; Tostevin-Cottie Mfg. Co. v. Ettinger, 254 Fed. 435, 166 C.C.A. 66; Silver Co. v. Sternau & Co., 258 Fed. 448, 169 C.C.A. 464.

> "The inquiry in the case at bar is: Did the inventors make the same contribution to the sum of human knowledge as was said in Bird v. Elaborated Roofing Co., supra? If so, the claims are for the same invention, notwithstanding the lack of similarity in language or scope or number of elements. * * * "

If there is room for even a single invention in the simple concept of offsetting bar legs with transverse feet to one side of an ironing board to permit sit-down ironing (see Lowenberg Patent No. 1,976,031 at A. 55), there certainly is no room for two patents on the subject.

CONCLUSION

In view of the foregoing, a Writ of Certiorari should issue out of this Court directed to the United States Court of Appeals for the Seventh Circuit so that the decision of said Court of Appeals filed in this matter on March 30, 1961 may be reviewed by this Court.

Respectfully submitted,

MAXWELL H. HERRIOTT

Attorney for Petitioner

SUPPLEMENT A

IN THE

UNITED STATES COURT OF APPEALS

FOR THE SEVENTH CIRCUIT

September Term 1960—January Session 1961

No. 13144

GEUDER, PAESCHKE & FREY CO.,
Plaintiff-Appellant,
vs.
JOHN R. CLARK and J. R. CLARK COMPANY,
Defendants-Appellees.

Appeal from the United States District Court for the Eastern District of Wisconsin.

March 30, 1961

Before HASTINGS, *Chief Judge*, DUFFY, *Circuit Judge* and MERCER, *District Judge*.

DUFFY, *Circuit Judge*. Olander Patent No. 2,663,102 was issued on December 22, 1953 on a patent application filed June 9, 1950. The patent relates to ironing tables, and is particularly directed to the supporting structure for the table top.

On May 12, 1954, the J. R. Clark Company and John R. Clark (Clark) brought suit against Geuder, Paeschke & Frey Co. (GP&F) in the United States District Court for the Eastern District of Wisconsin, charging infringement of Claim 1 of the Olander patent. The District Court found Claim 1 of the patent valid and infringed.

Upon appeal to this Court, the judgment of the District Court was affirmed. *J. R. Clark Company v. Geuder, Paeschke & Frey Co.*, 7 Cir., 259 F. 2d 737. A petition for certiorari was denied on February 24, 1959. 359 U.S. 914.

The interlocutory judgment entered in the District Court contained an injunction against further infringement and adjudged that profits and damages recoverable from GP&F for patent infringement be determined by a Special Master who was appointed on April 13, 1959.

On May 4, 1959, there was published in 121 U.S.P.Q. 218, a decision of the United States Court of Customs and Patent Appeals that was released on April 21, 1959, with reference to the Hortman application.[1] The Board of Appeals of the Patent Office had rejected Claims 27 and 31 as failing to patentably distinguish over certain cited prior art patents. The Court reversed the Board of Appeals holding the two claims did define patentable subject matter. Claim 27 became Claim 14 of Hortman Patent No. 2,896,347 which was issued on July 28, 1959.

Alleging that Claim 1 of Olander Patent No. 2,663,102 is the same invention described in Claim 14 of Hortman Patent No. 2,896,347, and pointing out that the application for the Hortman patent was filed almost three months earlier than the Olander patent, plaintiff commenced this independent action seeking a permanent injunction restraining Clark from enforcing its interlocutory judgment.

Clark filed a motion to dismiss the complaint upon the grounds that 1) under the doctrine of *res judicata*, GP&F

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[1] This decision was later published as *Application of Hortman*, 264 F. 2d 911.

is bound by the judgment in the suit wherein Claim 1 of the Olander patent was found valid and infringed, and 2) the complaint failed to state a claim upon which relief could be granted, and the issuance of the Hortman patent gives rise to no defense not previously considered. Clark later filed a motion for summary judgment and supporting affidavits. Counter-affidavits were filed. The District Court held it was without jurisdiction to enjoin the enforcement of the judgment in favor of Clark and, therefore, granted Clark's motion for summary judgment.

The issue to be here resolved is whether leave of this Court is required for a District Court to exercise jurisdiction in an independent action which seeks to enjoin a party from enforcing a judgment in its favor, which judgment has been affirmed and approved by this Court.

The learned District Judge succinctly stated his reasons for believing the District Court was without jurisdiction. In his opinion he stated:

> "It is clear that had G.P.&F. moved in the original case for a new trial pursuant to Rule 60(b) of the Federal Rules of Civil Procedure, this court would have lacked jurisdiction to entertain that motion. *Butcher & Sherrerd v. Welsh, supra.* G.P.&F. contends, however, that the court can do in an independent action what it clearly could not have done in the original action, that is, nullify the effect of a judgment which was affirmed on appeal, because of newly discovered evidence.
>
> "We can see no reason for application of a different rule to independent actions than that applicable to motions for a new trial, or for holding that this court can do by indirection what it could not do directly."

Rule 60(b) Fed.R.Civ.P. provides that upon motion a party may be relieved from a final judgment for various

reasons including "newly discovered evidence which by due diligence could not have been discovered in time to move for a new trial under Rule 59(b); . . ." Based on such a reason, the motion must be made within one year after the entry of the judgment.

Rule 60(b) also provides: "This rule does not limit the power of a court to entertain an independent action to relieve a party from a judgment, order, or a proceeding, or to grant relief to a defendant not actually personally notified . . . or to set aside a judgment for fraud upon the court."

The parties to this suit seem to agree that if a judgment has not been appealed, the District Court, under certain conditions, has the power to relieve a party from a judgment, either by a motion under Rule 60(b) or by an independent suit. The controversy before us arises because the judgment of the District Court was appealed, and our Court affirmed that judgment, and our mandate was thereafter returned to and filed with the District Court.

The District Court relied principally upon three cases: *In re Potts,* 166 U.S. 263; *Butcher & Sherrerd v. Welsh,* 3 Cir., 206 F. 2d 259; and *City of Orlando v. Murphy,* 5 Cir., 94 F. 2d 426.

In the *Potts* case, *supra,* the Supreme Court relied upon and quoted as follows from *In re Sanford Fork and Tool Co.,* 160 U.S. 247, 255,

> "When a case has been once decided by this court on appeal, and remanded to the Circuit Court, whatever was before this court, and disposed of by its decree, is considered as finally settled. The Circuit Court is bound by the decree as the law of the case; and must carry it into execution, according to the mandate. That court cannot vary it, or examine it for

any other purpose than execution; or give any other or further relief; or review it, even for apparent error, upon any matter decided on appeal; or intermeddle with it, further than to settle so much as has been remanded."

In the *Welsh* case, *supra*, the case was originally tried in 1944, and plaintiff obtained a judgment. The Court of Appeals affirmed and the mandate was returned to the District Court. In 1946, defendants made a motion for a new trial on the ground of newly discovered evidence. A petition was filed with the Court of Appeals asking leave for the District Court to consider the motion. The petition was denied, and the mandate was returned to the District Court. In 1948, there was a "renewal" of the motion for a new trial. This was denied by the District Court and the Court of Appeals affirmed.

In 1952, defendants, without applying for leave of the Court of Appeals, filed another motion for a new trial, and the District Judge granted the motion. The trial judge relied upon Rule 60(b). The Court of Appeals stated, page 262:

". . . Where a judgment has been affirmed on appeal and the mandate handed down it is beyond the power of the lower court to disturb the judgment without leave of the appellate court. . . . What is here involved is an utter lack of jurisdiction to act. . . .

"Respondent contends that recent amendments to Rule 60(b) of the Federal Rules of Civil Procedure confer upon the trial court the power to grant relief from the operation of a judgment without prior approval of the appellate court. We cannot subscribe to this contention. Rule 60(b), while enlarging the power of the District Courts over judgments . . . does not confer upon District Courts the power to alter or amend a judgment which has been affirmed by this Court or the Supreme Court, for such alteration

would affect the decision of the reviewing court, which it is not within the power of the District Courts to do."

GP&F insists that these two cases do not limit the power of a District Court to enjoin enforcement of a judgment when such relief is sought in an independent action. GP&F insists that the savings clause in Rule 60(b) preserves the jurisdiction of the District Court to entertain such an independent action. The argument is made that the cases relied on by Judge Tehan are distinguishable because they involved ancillary proceedings and were not independent actions.

Ignoring the lack of any direct precedent to support GP&F's position, we think there is no reasonable basis for applying a different rule in the case of an independent action. The reasons usually cited for requiring leave of an appellate court in an ancillary proceeding are likewise applicable to an independent action. Among such reasons are, finality of judgments; absence of power in the lower court to change or revise the mandate of an appellate court, and the authority and rightful concern of an appellate court to protect the integrity of its judgments.

We hold that the District Court was correct in holding that it did not have jurisdiction to entertain the independent action without leave having first been obtained from this Court.

The second issue in this suit is the alternative request of GP&F that this proceeding be treated as one seeking from this Court leave for the District Court to entertain the independent action. In *Pickford v. Talbott*, 225 U.S. 651, 657, the Court held that a showing must be made that it would be manifestly unconscionable for the successful adversary to enforce the judgment.

If, from the record before us, we are able to determine that Hortman Patent No. 2,896,347 and Olander Patent No. 2,663,102 are not the same invention, it would be a useless gesture to grant GP&F leave to file its action in the District Court.

In the case which was here previously on appeal, the District Court held Claim 1 of the Olander Patent No. 2,663,102 was "good and valid in law." It also held the "Mary Proctor" ironing table did not suggest the invention of the patent in suit, and that the Mary Proctor table is substantially identical with the Hild Patent No. 2,546,097 which the Patent Examiner considered and rejected. We affirmed the District Court's decision.

The Mary Proctor table was manufactured by Proctor Electric Company, the assignee of the Hortman patent. Clark insists the ironing table disclosed by Hortman in Patent No. 2,896,347 is substantially, if not actually, identical with the Mary Proctor table considered by us on the previous appeal.

The decision of the United States Court of Customs and Patent Appeals (264 F. 2d 911) in allowing Hortman Claim 14, did not pass upon the validity of Claim 1 of the Olander patent. We were informed on oral argument in the case at bar that the attention of the Court of Customs and Patent Appeals was directed to the decision of this Court, sustaining the validity of Claim 1 of Olander Patent No. 2,663,102, but in the opinion of the United States Court of Customs and Patent Appeals, no mention is made of our decision. It is a legitimate inference that that Court did not intend to hold that Olander was not the inventor of the subject matter of Claim 1 of his patent.

Also to be considered is that Claim 14 of the Hortman Patent did not exist until May 3, 1957 which was nearly four years after the Olander Patent was issued.

In considering whether the enforcement of the judgment in the case here previously would be unconscionable, we may consider that GP&F vigorously litigated the issue of validity and infringement of the Olander Patent in the trial court, in this Court, and petitioned the Supreme Court for certiorari. Both the District Court and this Court noted that GP&F deliberately copied the Olander invention immediately after it appeared on the market. Also, that in the course of the litigation, GP&F sold its ironing table business to Jones & Laughlin Steel Corporation. As a result of this sale, Clark felt compelled to prosecute a new suit in the United States District Court for the Southern District of Indiana.

Although the phraseology of Claim 14 of the Hortman Patent and Claim 1 of the Olander Patent are, in some respects, similar, there are important differences. The two claims are directed to different concepts and combinations of elements. Claim 14 of the Hortman Patent does not respond to certain limitations contained in Claim 1 of the Olander Patent.

We conclude there are no reasons in equity why the enforcement of the judgment in the previous case should be restrained. Therefore, considering the instant appeal as a petition to this Court to grant leave to the District Court to entertain the independent action, such petition is denied.

Judgment

AFFIRMED.

SUPPLEMENT B

UNITED STATES COURT OF APPEALS

FOR THE SEVENTH CIRCUIT

Chicago 10, Illinois

Thursday, March 30, 1961

Before

Hon. JOHN S. HASTINGS, Chief Judge

Hon. F. RYAN DUFFY, Circuit Judge

Hon. FREDERICK O. MERCER, District Judge

No. 13144

GEUDER, PAESCHKE & FREY CO.,
Plaintiff-Appellant,
vs.
JOHN R. CLARK and J. R. CLARK COMPANY,
Defendants-Appellees.

Appeal from the United States District Court for the Eastern District of Wisconsin.

This cause came on to be heard on the transcript of the record from the United States District Court for the Eastern District of Wisconsin, and was argued by counsel.

On consideration whereof, it is ordered and adjudged by this court that the judgment of the said District Court in this cause appealed from be, and the same is hereby, AFFIRMED, with costs, in accordance with the opinion of this Court filed this day.

In the
Supreme Court of the United States

OCTOBER TERM 1960

No. 182

GEUDER, PAESCHKE & FREY CO., A CORPORATION
Petitioner

vs.

JOHN R. CLARK, AND THE J. R. CLARK COMPANY
Respondents

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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In the
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No. 182

GEUDER, PAESCHKE & FREY CO., A CORPORATION
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Respondents

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

FOREWORD

Respondents take no exception to petitioner's preliminary statement in the Petition (p. 1); nor to the references to the OPINIONS BELOW; nor that JURISDICTION (p. 2) is being invoked under 28 USC No. 1254(1).

Respondents deny that the "QUESTION (as) PRESENTED" (pp. 2-4) is one that justifies the attention or warrants the intervention of this Court. More specifically respondents deny that either the Court of Appeals for the Seventh Circuit erred in its decision reported at 288 F.2d 1, or that the District Court erred in its decision as reported at 26 FRD 223. Respondents further deny that Claim 1 of the Olander patent and claim 14 of the Hort-

man patent are for "the same invention". Respondents still further deny that the alleged CONSTITUTIONAL PROVISION AND STATUTES INVOLVED, as quoted on pages 4-5 of the Petition, are of any consequence in the present proceedings.

RESPONDENTS' STATEMENT OF THE CASE

Not one of the grounds prescribed by Rule 19 of this Court, as governing reviews on certiorari, is present in this case. Thus, there are no special or important questions involved. In fact there are no issues presented that cannot be and have not already been resolved by the most elementary rules of law.

The original Complaint, charging petitioner (G. P. & F.) with infringement of claim 1 of the Olander patent No. 2,663,102 was filed by respondents (Clark) in the District Court for the Eastern District of Wisconsin on May 12, 1954. After full trial and arguments the Trial Court, by Chief Judge Robert E. Tehan, found the Olander claim in suit valid and infringed (159 F.Supp. 948).

The Trial Court's judgment was affirmed by the Court of Appeals for the Seventh Circuit, in its decision of October 10, 1958, reported at 259 F.2d 737, and on February 24, 1959 this Court denied a Petition for Writ of Certiorari, 359 U.S. 914.

The merits of the case having been disposed of a Special Master was appointed to take the account, and evidence having been taken his Report was rendered and is now before the District Court for approval or possible modification.

Insofar as validity or infringement of claim 1 of the Olander patent is concerned a complete round of litigation has occurred and in all three courts G. P. & F. has, on every contention, been soundly defeated.

In short, the present petitioner (G. P. & F.) has not only had its day in Court, but has exhausted every conceivable avenue of appeal and review.

In the present suit petitioner sought to escape or at least delay a money judgment in the original suit, not by reopening the parent action, as would normally be attempted where allegedly new evidence is pleaded, but by an entirely separate or "independent action" in which it prayed that the Clarks "be enjoined, pendente lite and permanently, from enforcing" the judgment entered in the original suit.

The sole basis for the Complaint in the present case, and the only reason advanced for its justification, is that the Olander claim 1 should be declared invalid because of the issuance on July 28, 1959 of the Hortman patent No. 2,896,347 containing Claim 14 which petitioner contends is for the same invention as that defined by claim 1 of Olander.

On granting Respondents' Motion for Summary Judgment, for lack of jurisdiction, the District Judge pointed out (App. 106) that—

> "no case has been found in which the lower court was held authorized to entertain an independent action to enjoin enforcement of a judgment which has been affirmed by a higher court where the sole ground for relief set forth in the independent action is newly discovered evidence."

He also noted, inter alia (App. 108), that—

> "More than adequate time was given for exhaustive investigation and preparation for trial. When the parties stipulated as to the issues, it was with the clear understanding that these were the only issues and that resolution of them would fully and finally determine the litigation."

The Court of Appeals for the Seventh Circuit not only affirmed the District Court on the jurisdictional issue, but went further in specifically holding that there were "important differences" between the compared claims of Olander and Hortman, in that

> "The two claims are directed to different concepts and combinations of elements."

ARGUMENTS

I.

The petition fails to make out even a prima facie case for review by certiorari.

In addition to failing to comply with the provisions of this Court's Rule 19, the present Petition, insofar as it pretends to rely on the Constitution and on Sections 102 and 103 of the Patent Act of 1952, is completely without merit, because it fails to point out anything done or said by either the trial or appellate courts, and in either this or the original action, which could be construed as an attempted interpretation of these constitutional or statutory provisions of the law. The Petition raises a wholly academic issue as to the meaning of these provisions citing authorities with none of which the courts deciding this case have, even remotely, differed.

Secondly, the Mandate of the Court of Appeals, in the present action, was issued to the District Court on April 26, 1961, and no attempt has been made by petitioner to recall that Mandate. Consequently, and since the proceedings in the parent suit are now closed, insofar as the merits are concerned, the present Petition obviously raised issues which are purely moot.

II.

Neither issuance of the Hortman patent nor anything decided by the U. S. Court of Customs and Patent Appeals can possibly affect the two judgments now entered against petitioner, G. P. & F.

The foregoing contention is supported by many reasons, of which we merely list the following.

(a) Claim 1 of Olander and Claim 14 of Hortman are NOT for the same invention, a fact which becomes obvious from a mere reading of the two claims as they appear in the Petition (pp. 2-3).

(b) The Court of Appeals stated that there are "important differences" between the two claims in that they "are directed to different concepts and combinations of elements." The Petition contends (p. 10) that this "is a mere conclusion" by the appellate Court, but what of it? It is a factual conclusion and therefore entitled to great weight. Furthermore, and since neither Hortman nor Proctor Electric Company, owner of the Hortman patent, nor anyone else directly concerned with the Hortman patent, are in any way involved in this litigation, neither the Court of Appeals nor respondent are under any obligation to list the many distinguishing limitations in the two claims, as that, too, would be a purely moot situation.

(c) Petitioner itself recognizes (pp. 16-19) that there are several differences between the Hortman and Olander claims, but attempts to dispose of them by arguing that the differences are not "inventive" or "patentable," thus raising an entirely different and also moot issue.

(d) If, by any stretch of interpretation, the Olander and Hortman claims can be said to be for the "same

invention" then they are "interfering patents," and, under 35 U.S.C. 291, only the owners of "interfering patents" may ask the courts for relief. Here neither of the owners of the patents in question are seeking such relief and for the reason, inter alia, that they are not for the same invention. In fact, since Proctor Electric Company would be an indispensable party to any action involving the Hortman patent, neither this Court nor either of the lower courts could have any jurisdictional interest in it. Dooley Improvements Inc. v. Motor Improvements Inc., 66 F.2d 553, c.d. 54 S.Ct. 127, 290 U.S. 689, and Engler v. General Electric, 144 F.2d 191.

(e) When allowing the Hortman Claim 14, in Application of Hortman, 264 F.2d 911 (an ex parte proceeding), the Court of Customs and Patent Appeals did not adjudicate the Olander patent, and as noted by the Court of Appeals (Pet. p. 26) "It is a legitimate inference that that Court (C.C.P.A.) did not intend to hold that Olander was not the inventor of the subject matter of Claim 1 of his patent."

(f) Petitioner's contention (p. 6) that the Court of Customs and Patent Appeals "judicially interpreted" Claim 14 of Hortman is erroneous or at least not accurate. All the Court did was to hold the Claim patentable over prior art there of record. It did not adjudicate the validity of the claim, as has been done with the Olander claim, and certainly did not have the benefit of an adversary contest.

(g) Finally, the Hortman patent discloses, i.e., shows and describes nothing more than the old "Mary Proctor" ironing table, which was heavily relied upon by petitioner as prior art in the parent case, and which was rejected by

both lower courts as *not* being anticipatory of the Olander claim. Thus, the Court of Appeals clearly held (259 F.2d 737) that—

> "We likewise agree with the statement of the district judge that the Mary Proctor ironing table * * * does not suggest the invention of the (Olander) patent in suit."

III.

The equities clearly and fully support respondents' position.

This action was initially presented as one "authorized by Rule 60(b) of the Federal Rules of Civil Procedure." It subsequently developed that petitioner had not even remotely qualified itself under that Rule, which no doubt accounts for the fact that no mention is even made of it to this Court.

The Petition now proceeds on the theories that "public interest requires the striking down of" the Olander patent (p. 10), and that "enforcement of a judgment based on Olander Claim 1 should be enjoined" because it would be "unconscionable" (p. 15). Little argument is needed to demonstrate the utter fallacy of these theories.

Aside from the fact that petitioner is clearly in no way concerned about "public interest" there is nothing in the record that even remotely suggests that any such interest exists. And when Petitioner has not even been able to show that Hortman or Proctor Electric is interested then the argument must be summarily rejected.

In urging that enforcement of the original judgment is "unconscionable" petitioner appeals to the equity side of the Court, and in doing so gets into a net from which it cannot possibly extricate itself. What then are the established equities in the present situation.

In the first place, this was not an innocent infringement. When the Clark (Olander) table was first displayed it was immediately and intentionally copied by petitioner G. P. & F. (159 F.Supp. 948, 949-50, Findings 12 to 18. See also 259 F.2d 737, at 738). When this case came before the Court of Appeals, it said that

> "Both the District Court and this Court noted that G. P. & F. deliberately copied the Olander invention immediately after it appeared on the market" (288 F.2d 1, at 4).

Significantly, G. P. & F. did not copy the Hortman design or the Mary Proctor table then on the market.

Secondly, and as also noted by the Court of Appeals (at 288 F.2d 1, 4)

> "Also, that in the course of the litigation, G. P. & F. sold its ironing table business to Jones & Laughlin Steel Corporation. As a result of this sale, Clark felt compelled to prosecute a new suit in the United States District Court for the Southern District of Indiana."

In the District Court's decision, in the Indiana suit (186 F.Supp. 22), Chief Judge Steckler granted Clark's motion for summary judgment, noting as "admitted and somewhat surprising facts that * * * Jones & Laughlin, with full knowledge of the Wisconsin suit—purchased from Geuder, Paeschke & Frey the assets of that firm's Consumer Products Division which manufactured and sold ironing tables" which it continued to manufacture.

That decision was affirmed by the Court of Appeals at 288 F.2d 279.

A third factor, bearing on the equities in this case, is that since the original suit was filed against G. P. & F.

on May 12, 1954, it has done everything within its power to delay the final judgment against its wrongdoings, and with apparently inexhaustible resources has put Clark to the trouble and expense of fighting three law suits, all of which have been successively carried to this Supreme Court. This has wasted untold hours of Courts' and counsels' time, which can only be classified as futile litigation of the most vexatious type.

IV.

The authorities fully support respondents' position on all issues presented.

As the controlling authorities, bearing on all questions here in issue, have been fully considered and properly applied by the District Court and the Court of Appeals, in their respective decisions, further discussion of those decisions seems unnecessary.

We do, however, wish to comment on a newly cited opinion on which petitioner now and somewhat strangely places weight. Reference is made to a quotation from Judge Manton in International Signal Co. v. Vreeland Apparatus Co., 278 Fed. 468, appearing on pages 18-19 of the Petition. There are a number of cogent reasons why that case does not support the petitioner's position.

In the first place Judge Manton's conviction of conspiracy to obstruct the administration of justice, and particularly in connection with several patent suits (U. S. v. Manton et al., 107 F.2d 834, c.d. 309 U.S. 664, 6 S.Ct. 590), hardly establishes him as an authority on patent law or the equitable aspects thereof.

Secondly, the opinion quoted from in the Petition was a dissenting opinion and was therefore not even the controlling law of that case.

Thirdly, and of paramount importance, the majority opinion is one that clearly follows long established principles of patent law and therefore fully supports respondents' position.

Thus, the International Signal case was one in which the parties to the suit were owners of the allegedly conflicting patents, and (p. 470)

> "The aim (was)—to determine priority of invention, and, on the basis thereof, to annul the patent erroneously and/or inadvertently issued."

In short it was an "interfering patents" suit brought under Sec. 4918 R.S., now 35 U.S.C. No. 291, in which the owners of the patents are undispensable parties.

Of greater importance, however, the court held that the claims in the two patents were not for the same invention, and that the court could not, in such a suit, pass on patentability of one claim over the other.

> "If, then, the concededly junior patentee is claiming an alleged specific improvement of the prior and basic patent, the patentability of the alleged improvement is not the subject-matter of an interference suit" (p. 470)

* * * * *

> "Only the clearest conviction of identity of claims would justify the court now to find an interference."

The court then relied on the Supreme Court decision in Hildreth v. Mastorus, 257 U.S. 27, 42 S.Ct. 20, wherein it was said—

> "The presumption of priority and novelty (and, we may add here, non-interference) which arises from the granting of a patent must have greatly increased weight, and the claim of the inventor is subjected to

such close and careful scrutiny under the stimulus of a heated contest."

CONCLUSION

Manifestly, the "QUESTION PRESENTED" by the Petition is not present in this case and since the issues discussed are either purely academic or moot the Petition should be denied.

Respectfully submitted.

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NOTICE OF SERVICE

This is to certify that four copies of this brief have been served on Maxwell H. Herriott, counsel for petitioner, by mailing the same to him at his last known address, this — day of July, 1961.

ANDREW E. CARLSEN

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JAMES R. BROWNING, Clerk

IN THE

SUPREME COURT OF THE UNITED STATES

October Term, 1961

No. 182

GEUDER, PAESCHKE & FREY CO.,
a corporation,

Petitioner,

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and
J. R. CLARK COMPANY,

Respondents.

REPLY BRIEF OF PETITIONER IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

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1. Respondents at pages 2 and 4 of their brief assert that petitioner has failed to comply with Court Rule 19 which does not even purport to be exhaustive of the reasons for granting a Writ of Certiorari. The issue here, i.e., the invalidity of Olander Claim 1 because Hortman

Claim 14 describes the same invention, presents a matter of public importance and the failure of petitioner to raise that issue would thwart the public interest. *Edward Katzinger Co. v. Chicago Metallic Mfg. Co.*, 329 U.S. 394, 400 (1947). Thus, as stated in *Veaux v. Southern Oregon Sales, Inc.*, 33 F. Supp. 605 (D.C. Ore. 1940), at page 610:

> *"However, the interests of the public are always involved in a patent case and the public has to be protected from unjust monopoly. Even if plaintiff and defendant should stipulate that invention was present, the court should consider the question.* The cause has been fully tried and, without regard to the interests of the plaintiff or the punishment of the defendant, the rights of the public must be declared. Monopoly in any field should be curbed unless it appears that the public is receiving a benefit from the grant of which otherwise it would be deprived. The expense and trouble caused private claimants in trying to find the pot of gold at the end of the rainbow is to be deplored, *but neither should be recompensed at the expense of the public.* * * *" (Italics supplied)

See also *Densmore v. Scofield*, 102 U.S. 375, 378 (1880) and *Cridlebaugh v. Rudolph*, 131 F. (2d) 795, 800 (3rd Cir. 1942).

2. Respondents also at pages 2 and 4 of their brief make the astounding assertion that the constitutional provision and the statutes relating to patents are of no consequence and present an academic issue because the Court of Appeals did not see fit to refer to them. The Constitution and statutes, and the decisions cited by petitioner, expressly declare that (a) only one patent can be issued for a single invention, (b) the right to such grant is in the first inventor, and (c) a prior filing date establishes prior inventorship in the absence of other proof. Both the Con-

stitution and the statutes would be violated by the decision of the Court of Appeals in this case it, as petitioner contends, Olander Claim 1 and Hortman Claim 14 described the same invention.

3. Respondents at pages 3 and 7 of their brief refer to the issue of jurisdiction that was raised in the lower courts. The District Court found a lack of jurisdiction under Federal Rule of Civil Procedure 60(b) because petitioner had not first obtained leave from the Court of Appeals to commence this independent action. This question of jurisdiction, however, became moot when the Court of Appeals treated the brief of petitioner on appeal as a request for leave to commence this action and then ruled on the merits of the issue presented. Under the circumstances involved here this Court should not be burdened with the jurisdictional issue, which involved the power of a District Court to entertain an independent action, to enjoin enforcement of a judgment of its appellate court because of an event which occurred after the judgment of said appellate court.

4. Respondents at page 4 of their brief argue that since petitioner has made no attempt to recall the mandate from the District Court, the issue raised in the Petition for Writ of Certiorari has become moot. The issuance of the Court of Appeals mandate to the District Court cannot affect the jurisdiction of this Court as to this Petition. *Carr v. Zaja*, 283 U.S. 52 (1931) and *Aetna Casualty Co. v. Flowers*, 330 U.S. 464, 467 ('947).

5. Respondents, on page 5 of their brief, following the course charted by the Court of Appeals, treat the identity of invention issue summarily and make no effort to specify even one of the alleged inventive differences between Hortman Claim 14 and Olander Claim 1. They

also assert the identity of invention question presents an issue of fact and hence limits the jurisdiction of this Court. However, this Court held long ago in *Miller v. Eagle Manufacturing Co.*, 151 U.S. 186, 196-197 (1893):

> "If, upon a proper construction of the two patents—*which presents a question of law to be determined by the court,* (Heald v. Rice, 104 U.S. 737, 749), and which does not seem to have been passed upon and decided by the court below—they should be considered as covering the same invention, *then the later must be declared void,* under the well-settled rule that two valid patents for the same invention cannot be granted either to the same or to a different party." (Italics supplied)

The conclusory ruling of the Court of Appeals is not entitled to the weight respondents ascribe to it and the scope of review by this Court on the issue presented is not limited.

Petitioner has been unable to perceive patentable differences of any kind between said claims of said two patents and neither the Court of Appeals nor respondents have specified any of the alleged differences. Since a mere reading of the two claims demonstrates that alleged patentable "differences" are non-existent this Court should so declare in the public interest.

6. Respondents on page 6 of their brief argue that the statute relating to interfering patent actions (35 USC § 291) prohibits this Court from comparing the claims in question, i.e., deciding the issue of law involved, because the owner of the Hortman patent is not a party.

On its face, that statute merely authorizes a special form of relief for one patent *owner against another owner* when their issued patents interfere, because an infringement suit may not be possible. Moreover, petitioner

in this case is not seeking to have the Hortman patent invalidated but is attacking a claim of the Olander patent, whose owner is a party to this suit.

Furthermore, 35 USC §282 specifically provides the conditions for patentability set forth in 35 USC §102 shall be defenses in "*any* action involving the validity or infringement of a patent." (Italics supplied) If the rule were otherwise, then, whenever a defendant in an infringement suit pleaded prior art evidenced by an outstanding patent, such prior art would not be available as a defense if the owner of that prior art patent was not within the jurisdiction of the forum chosen by plaintiff.

The absurdity of the respondents' interfering patent argument is further illustrated by *Sundh Electric Co. v. Interborough Rapid Transit Co.*, 198 Fed. 94 (2nd Cir., 1912), wherein Claim 3 of the patent in suit was compared with Claim 3 of a later patent issued on a prior filed application, a situation which obtains here. The owner of the second patent was not a party. The Court found the claims to be for the same invention and adjudged the patent in suit invalid because the patentee was not the first inventor. See also *Alexander Milburn Co. v. Davis-Bournonville Co.*, 270 U.S. 390 (1926) and *Detrola Corp. v. Hazeltine Corp.*, 313 U.S. 259 (1941).

7. Respondents at page 6 of their brief assert *Application of Hortman*, 264 F. (2d) 911 (1959) was an ex parte and non-adversary proceeding, even though the Patent Office and Hortman were completely at odds and filed opposing briefs in the Court of Customs and Patent Appeals. While that court did not and could not pass upon the validity of Olander, it did hold Hortman Claim 14 described patentable subject matter specified in the claim as the offsetting of the leg structure of an ironing table to provide sufficient room for sit-down ironing.

8. Respondents at pages 6 and 7 of their brief assert that Hortman Claim 14 discloses no more than the "Mary Proctor" ironing table relied upon by petitioner as prior art in the first case. The Court of Appeals for the Seventh Circuit held that said *table,* which had one single and one double bar leg, did not "suggest" the invention described in Olander Claim 1. (259 F. 2d 737, 739) However, Hortman Claim 14 in very clear language specifically teaches the invention described in Olander Claim 1, to-wit, a leg structure not limited to one with a double bar leg, but:

> "* * * of sufficiently narrower width than said top, and being laterally offset in relation to the longitudinal axis of said top sufficiently, at least in those portions to be disposed in the vicinity of the user's knees, to provide room for the knees opposite said portions beneath the top and thereby permit use of the table for sit-down ironing."

9. Respondents at pages 7-9 of their brief also make the illogical argument that even though the judgment sought to be enjoined is based upon a void patent, the enforcement thereof cannot be classified as "unconscionable" in view of the equities between the parties. Equities of the parties cannot override the public interest involved when a void patent remains outstanding.

An invalid patent is never enforceable, not even when the invalidity arises out of an administrative error, of which the inventor is entirely innocent. *Marsh v. Nichols, Shepard & Co.,* 128 U.S. 605 (1888). It is an often repeated principle that there can be no infringement of an invalid patent. When Olander failed to contribute anything patentably new to the arts there was no consideration for the patent grant, and his assignee Clark should not receive an unearned enrichment in the form of a

money judgment. This Court has said that a patent such as the one here "must be declared void". See *Miller v. Eagle Manufacturing Co.*, 151 U.S. 186, 196-197 (1893).

While the so-called equities are of no consequence in applying the foregoing principles, petitioner denies that any "equities" lie in favor of respondents. The alleged copying, as well as initial making and selling, by petitioner occurred *before* the Olander patent issued. As the record discloses, petitioner introduced its knee room table only after two competitors had already marketed theirs. Petitioner had the perfect right to meet competition, for as stated in *Smith v. Dravo Corp.*, 203 F. 2d 369, 375 (7th Cir. 1953):

> "It is unquestionably lawful for a person to gain possession, through proper means, of his competitor's product and through inspection and analysis, create a duplicate, *unless, of course, the item is patented.* * * *" (Italics supplied)

It also is difficult to understand how such copying can be characterized as "deliberate and willful", or even copying, when the Court of Appeals in the prior case had to resort to the doctrine of equivalents (259 F. 2d 737, 740) to uphold the finding of infringement. The remarks in *Union Carbide Corp. v. Graver Tank & Mfg. Co.*, 282 F. 2d 653 (7th Cir. 1960) (certiorari denied Feb. 20, 1961, 356 U.S. 812) at page 658 apply:

> "If Lincoln had copied its flux from the patent, that, as the Supreme Court said, would have been 'the end of it', and there would have been no occasion to resort to the doctrine of equivalents. That doctrine rests upon the premise that the infringer made something different. *It strikes us as an anomaly to find that Lincoln copied from the patent but that infringement was found only by application of the doctrine of equivalents.* * * *" (Italics supplied)

and again at page 662:

> "Bad faith should not be attributed to Lincoln because it contested and lost on the issue of infringement. Many a legal battle has been fought honestly and in good faith, but lost."

Nor can the sale by petitioner of the Consumer Products Division of its business before the judgment of infringement be utilized to balance equities against it. Of such business, as respondents well know, the infringing tables were only one of several product lines of said Consumer Products Division and trivial in dollar amount (see page 4 of Petition for Certiorari in Docket No. 199) and the purchaser had resold said ironing board business and ceased infringement before respondent sued the purchaser (see page 5 of Petition for Certiorari in Docket No. 199).

10. Opposing counsel on pages 9 and 10 of his brief distinguishes a case which he incorrectly refers to as being newly cited, to-wit: *International Signal Co. v. Vreeland,* 278 F. 468 (2nd Cir. 1921). No distinction is necessary. That decision was an "interfering patent" suit, which is quite different from the instant case. The court, by reason of the limited purpose of the interference statute, held that in such an action it would be improper to determine patentability of the claim of one party over that of the other party when the claims did not actually interfere. The portion of the decision, which was properly classified as a dissent on page 18 of the Petition for Writ of Certiorari, was cited only for quoted propositions of law which are clearly correct in resolving an issue of the kind now before the Court.

Respondents on pages 10-11 of their brief misquote and add to the opinion by this Court in *Hildreth v. Mas-*

toras, 257 U.S. 27, 32 (1921). That case holds that the presumption of invention which arises from the granting of a patent must have greatly increased weight *when* the claim of the inventor is subjected to close and careful scrutiny in a heated interference proceeding in the Patent Office itself, a situation which does not exist with respect to the Olander Claim 1 because the Patent Office at all times denied Hortman Claim 14.

CONCLUSION

Manifestly 1) the question involved is neither academic or moot, 2) the owner of the Hortman patent is not an indispensable party in this lawsuit, and 3) if Hortman Claim 14 and Olander Claim 1 are for the same invention, Olander Claim 1 is void on the basis of the record and enforcement of a judgment based thereon would be unconscionable and against the public interest.

A Writ of Certiorari should issue to the United States Court of Appeals for the Seventh Circuit so that its decision filed in this matter on March 30, 1961, may be reviewed by this Court.

Respectfully submitted,

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